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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,263	07/22/2003	John S. York JR.	67086-003	7338

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EXAMINER

FLANDRO, RYAN M

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 09/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/624,263

Applicant(s)

YORK ET AL.

Examiner

Ryan M Flandro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

1. Claims 1, 9, 15 and 17 are objected to because of the following informalities:
  - a. Claim 1. Line 5 of claim 1 recites “a plurality of vertical spokes secured to said top rail and said **vertical** rail” (emphasis added). The word “vertical” should be changed to --bottom-- since a “bottom rail” is previously recited in line 3 and also in order to meet the structure shown in the drawings and set forth in the written description.
  - b. Claim 9. Line 3 of claim 9 recites “...said projection of said first **vertical** rail is received” (emphasis added). The word “vertical” should be changed to --bottom-- since the projection is previously recited in claim 2 as being at each end of the “bottom rail” and also in order to meet the structure shown in the drawings and set forth in the written description. Likewise, lines 4-5 of claim 9 recite “...said projection of said second **vertical** rail is received in said **opening** of said second vertical rail” (emphasis added). The word “vertical” should be changed to --bottom-- since the projection is previously recited in claim 2 as being at each end of the “bottom rail”; the word “opening” should be changed to --notch-- in order to maintain consistency with the notch recited in line 3.
  - c. Claim 15. Lines 9-10 of claim 15 recite “...and one of said plurality of **vertical** holes” (emphasis added). The word “vertical” should be changed to --bottom-- since “bottom holes” are previously recited in line 4 and also in order to meet the structure shown in the drawings and set forth in the written description.
  - d. Claim 17. The following are suggestions to overcome minor informalities in claim 17: Insert the words --and bottom end-- after “top end” in line 8 of the claim to

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avoid antecedent basis problems based on the recitation of such in line 10 of the claim.

Insert the word --spokes-- after “vertical” in line 9 of the claim. Change the word “rail” in line 10 of the claim to --spokes-- for consistency. For purposes of examination, the Examiner has read the claim to include as much.

e. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Kusel (US 3,704,005).

a. Claim 15. Kusel shows and discloses a frame **10** including a first vertical rail **11**, a second vertical rail **12**, and a top rail **13** having a plurality of top holes (see column 2 lines 62-68); a bottom rail **14** including a plurality of bottom holes (see column 2 lines 62-68), a first end secured to said first vertical rail **11** and a second end secured to said second vertical rail **12**; and a plurality of vertical spokes **20** each including a top end **21a** shaped to fit in one of said top holes and a bottom end **21a** shaped to fit in one of said bottom holes, and at least one of said top end **21a** and said bottom end **21a** includes an end surface that engages a corresponding hole surface in one of said plurality of top holes and one of said plurality of [bottom?] holes (see figures 1 and 4; column 2 lines 62-68).

b. Claim 16. Kusel further shows and discloses each of said plurality of bottom holes (see column 2 lines 62-68) of said bottom rail **14** includes a flat surface (“notch”) and said bottom end **21a** of each of said vertical spokes **20** includes a flat portion, and said flat surface engages said flat portion to prevent rotation of said vertical spokes **20** (see figures 1 and 4; column 2 lines 62-68).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-4, 7 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilby et al (US 6,199,833) (Bilby) in view of Doublet (4,646,807).

a. Claim 1. Bilby shows and discloses a rail barricade **10** comprising a frame **12** including a first vertical rail **18**, a second vertical rail **20**, and a top rail **14**; a bottom rail **16** including a first end and a second end each secured to one of said vertical rails **18,20**, a plurality of vertical spokes **22** secured to said top rail **14** and said [bottom?] rail **16**; and first and second feet **24,26** pivotally attached to a bottom of a vertical rail **32** (see figures 1, 2 and 12; column 3 line 8 – column 4 line 15; column 6 lines 15-40). Bilby does not explicitly teach or disclose that the first and second feet **24,26** are attached to the bottoms of the first and second vertical rails **18,20**. Doublet, however, teaches that the feet **8,9** of a rail barrier may be attached at various points along the bottom of a frame **2** including at the bottom of the end vertical rails **3,4** of the frame **2** (see figure 1 and column 4 lines 4-14) as this type of foot mounting provides good stability to the barrier and minimizes the outer bulkiness of the barrier. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bilby to attach the pivotal feet **24,26** at the bottoms of the first and second vertical rails **18,20** for the reasons taught by Doublet.

Moreover, the Examiner notes that it has been held that rearranging the parts of a prior art device involves only routine skill in the art. See *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.) and *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious

matter of design choice). However, "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). As set forth above, the motivation requirement is believed to be met by the teachings set forth in Doublet.

b. Claim 2. Doublet further teaches said first vertical rail **3** has a first length and said second vertical rail **4** has a second length, and said first length is greater than said second length, and said first foot **8** has a first foot height and said second foot **9** has a second foot height, and said second foot height is greater than said first foot height (see figure 1 and column 4 lines 4-24).

c. Claim 3. Bilby shows and discloses said first foot **24** and said second foot **26** are each pivotal 90 degrees between an in use position and a storage position (see figure 1), and said first foot **24** and said second foot **26** are perpendicular to said top rail **14** and said bottom rail **16** when said first foot **24** and said second foot **26** are in said in use position (phantom lines) and said first foot **24** and said second foot **26** are parallel to said top rail **14** and said bottom rail **16** when said first foot **24** and said second foot **26** are in said storage position (bold lines) (see figure 1 and column 3).

d. Claim 4. Bilby, as modified by Doublet above, further includes said first foot **24** and said second foot **26** both include a vertical portion **36**, and said vertical portion **36** is

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inserted into one of said first vertical rail **18** and said second vertical rail **20**, and said vertical portion **36** further includes a pair of opposing cutouts **44** (see Bilby figures 2-4).

e. Claim 7. Bilby, as modified by Doublet above, further shows and discloses an attachment member **28** inserted into said cutout **44** of each of said first vertical rail **18** and said second vertical rail **20** to secure each of said first foot **24** and said second foot **26** to said first vertical rail **18** and said second vertical rail **20**, respectively (see figure 2).

f. Claim 11. The combination of Bilby and Doublet include that said plurality of vertical spokes **22** are attached to said top rail **14** and said bottom rail **16** by welding (see e.g. Doublet column 3).

g. Claim 12. Doublet further teaches at least one hook **15,16** attached to one of said pair of vertical rails **4** (see figures 1-4; columns 5 and 6).

h. Claim 13. Doublet further teaches a second rail barricade, and said at least one hook **15,16** secures said second rail barricade to said rail barricade **1** (see figures 1-4 and columns 5-6).

i. Claim 14. Doublet further shows said second rail barricade is pivoted 30 degrees relative to said rail barricade **1** to remove said second rail barricade from said rail barricade **1** (see figures 3a and 3b; columns 5-6).

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bilby and Doublet, as applied above, further in view of Lavine (US 5,186,197). Bilby again shows a cutout that allows rotation between members **32** and **36**, but lacks disclosure that said cutout **44** is z-shaped.

Lavine, however, teaches a bayonet-type connection similar to the connection in Bilby except

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that the cutout is z-shaped in order to allow rotation and axial extension between two inter-fitting members **16,30** (see figures 2 and 4-6; column 3 lines 21-41). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bilby to include a z-shaped cutout to allow relative axial extension of the connecting members **32,36** as taught by Lavine.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bilby and Doublet, as applied above, further in view of Christensen et al (US 6,676,113) (Christensen). The combination of Bilby and Doublet, as applied above, includes a vertical portion **36** that is pivotably attached to the first and second vertical rails **18,20**, but lacks a tube having a vertical slit and a hole, and said tube being positioned between said vertical portion and one of said first vertical rail and said second vertical rail. Christensen, however, teaches various configurations for pivotably attaching first and second feet **14,16** to a rail barricade **12** including one which includes a tube **192** having a vertical slit **152** and a hole **150**, and said tube **192** is positioned between a vertical portion **100** and the receiving portion within the wall **12** (see figures 1, 5, 6A, 6B, and 8 and the associated written descriptions). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the aforementioned tube between the vertical portion and the receiving vertical rail in Bilby and Doublet since such structure is considered art recognized equivalents as set forth by Christensen.

9. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilby in view of Doublet, further in view of Shull (US 4,358,214).

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a. Claim 8. Bilby and Doublet include said first end and said second end of said bottom rail 16 positively attached to the first and second vertical rails 18,20, respectively, but lack each of the first and second ends of the bottom rail including an end curvature that corresponds to a rail curvature of said first vertical rail and said second vertical rail. This type of connection is well known in the art, however, as demonstrated by Shull. Shull teaches a cylindrical member 22 attached perpendicularly to another cylindrical member 23 and expressly includes an end curvature 14a that corresponds to a rail curvature of a first and second vertical rail 12 in order to rigidify the end to side connection (see figures 2, 4, 8 and 9; columns 1-2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bilby and Doublet to include an end curvature on the bottom rail that corresponds to a rail curvature of a first and second vertical rail for the reasons taught by Shull.

b. Claim 9. Shull further teaches said first end and said second end of said rail 11 each include a projection 13 and said first and second vertical rails 12 each include a notch 17, and said projection 13 of said first [bottom] rail 12 is received in said notch 17 of said first vertical rail 12 and said projection 13 of said second [bottom] rail 11 is received in said [notch] 17 of said second vertical rail 12 (see figures 2, 4, 8 and 9; columns 1-2).

c. Claim 10. Doublet further teaches a bottom rail 6 secured to a first vertical rail 3 and a second vertical rail 4 by a weld (see column 3 lines 52-58).

10. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilby in view of Doublet, further in view of Kusel.

d. Claim 17 (as best understood – see objections above). The combination of Bilby and Doublet, as set forth above, necessarily includes the method of forming a rail barricade 10 comprising the steps of providing a frame 12 including a first vertical rail 18, a second vertical rail 20, and a top rail 14; providing a bottom rail 16 having a first end, and a second end; pivotally attaching a first foot 24 to said first vertical rail 18 (according to the teachings in Doublet – see above) and pivotally attaching a second foot 26 to said second vertical rail 20 (according to the teachings in Doublet – see above); providing a plurality of vertical spokes 22 each including a top end; securing said first end [of the bottom rail 16] and said second end [of the bottom rail 16] to said first vertical rail 18 and said second vertical rail 20, respectively (see Bilby figures 1, 2 and 12; see Doublet figure 1 and column 4 lines 4-14). The combination of Bilby and Doublet does not expressly include the top and bottom rails having a plurality of holes, nor does the combination include the step of inserting said top end of said vertical [spokes] into one of said top holes of said top rail and inserting said bottom end of said vertical [spokes] into one of said bottom holes of said bottom rail. Kusel, however, teaches top and bottom rails having a plurality of holes (see column 2 lines 62-68 – “notches”) as well as the insertion therein of the top and bottom ends 21a of vertical spokes 20 to form a wall section. Kusel teaches such construction to aid in ease of assembly and increase production efficiencies (see column 1 lines 55-60). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include holes in the top and bottom rails of Bilby to accept the top and bottom ends of the spokes extending therebetween for the reasons offered in Kusel.

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- e. Claim 18. Bilby further shows and discloses said first foot **24** and said second foot **26** are pivotal 90 degrees between an in use position (phantom lines) and a storage position (solid lines) (see figure 1).
- f. Claim 19. Both Doublet and Kusel utilize welds to secure the various members of the barriers together (see Doublet column 3 lines 30-68; see Kusel column 2 lines 62-68)

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art with respect to rail barricades:

- U.S. Patent 6,190,084 to Ibanez (see figures 1-3)
- U.S. Patent 5,402,988 to Eisele (see figures 1, 2, 8 and 9)
- U.S. Patent 5,354,037 to Venegas, Jr. (see figure 2)
- U.S. Patent 4,240,764 to Wegner (see figures 1, 3, 7 and 17)
- GB 2063956 to Hague et al.
- FR 2625238 to Beziat
- FR 2503227 to Doublet

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan M Flandro whose telephone number is (703) 305-6952. The examiner can normally be reached on 9:00am- 6:00pm Mon-Fri.

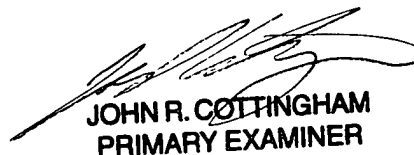
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703) 308-2686. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RMF

August 26, 2004



JOHN R. COTTINGHAM  
PRIMARY EXAMINER